



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,795	09/11/2000	Charles A. Lemaire	750.006US1	4145

7590

04/01/2003

Schwegman Lundberg Woessner & Kluth PA  
P.O.Box 2938  
Minneapolis, MN 55402

EXAMINER

PARDO, THUY N

ART UNIT

PAPER NUMBER

2175

DATE MAILED: 04/01/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/658,795

Applicant(s)

LEMAIRE ET AL.

Examiner

Thuy Pardo

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-16 and 18-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-16 and 18-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicant's Response filed on February 10, 2003 to Examiner's Restriction Requirement has been reviewed. Claims 1-9 and 17 have been amended and claims 18-34 have been added.
2. Claims 10-16 and 18-34 are presented for examination.

### *Claim Rejections - 35 USC § 102*

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 10-16 and 18-34 are rejected under 35 U.S.C. § 102(e) as being anticipated by **Sandhu et al.** (Hereinafter "Sandhu") U.S. Patent No. 6,347,307.

As to claim 10, Sandhu teaches the invention substantially as claimed, comprising:

receiving transactions from at least one service provider and at least one service consumer, wherein each transaction is associated with the service consumer [reviewing the Member's pricing request, 340 of fig. 2; col. 6, lines 56-59];

storing the transactions [col. 5, lines 18-21];

enabling access by the service consumer to stored transactions associated with the service consumer to whom access is enabled [enable users to communicate with CFOWeb system and information can be reused over a series of transaction between the parties, col. 5, lines 18-29; col. 6, lines 1-3]; and

accessing the stored transactions associated with the service consumer to whom access is enabled, the accessing being performed by the service consumer to whom access is enabled [360-380 of fig. 2; col. 7, lines 5-27].

As to claim 11, Sandhu teaches the invention substantially as claimed. Sandhu further teaches receiving transactions by a docketing provider [CFOWeb System, col. 4, lines 20 to col. 5, lines 21; fig. 1].

As to claim 12, Sandhu teaches the invention substantially as claimed. Sandhu further teaches viewing a log of pending action items [member monitors and reviews pricing offers, 360 of fig. 2; col. 7, lines 5-7].

As to claim 13, Sandhu teaches the invention substantially as claimed. Sandhu further teaches that the service consumer uses a browser to access the stored transactions [web browser, 30 of fig. 1].

As to claim 14, all limitations of this claim have been addressed in the analysis of claim 10 above, and this claim is rejected on that basis.

As to claim 15, all limitations of this claim have been addressed in the analysis of claim 11 above, and this claim is rejected on that basis.

As to claim 16, Sandhu teaches the invention substantially as claimed. Sandhu further teaches that the transaction is associated with a service matter [capital market transactions including the trading of financial products, see the abstract].

As to claims 18-21, it is a corresponding apparatus claims of claims 10-16 above; therefore, they are rejected under the same rationale.

As to claim 22, Sandhu teaches the invention substantially as claimed. Sandhu further teaches receiving an electronic message [E-mail, 140 of fig. 2], the system further comprising a decoder that extracts the transaction from the electronic message [fig. 17; col. 50, lines 59-65].

As to claim 23, Sandhu teaches the invention substantially as claimed. Sandhu further teaches an input device that obtains a database transaction [inherently having an input device in the Member/Provider System in order to obtain a transaction, see fig. 2];

an encoder that inserts the transaction into an electronic message [fig. 16; col. 6, lines 46-55; col. 48, lines 23-50]; and a transmitter that sends the electronic message to the receiver [350 of fig. 2].

As to claim 24, Sandhu teaches the invention substantially as claimed. Sandhu further teaches a database stored in the storage, the database holding data for a plurality of service consumers including the first service consumer and for the first service provider [system database, 110 of fig. 2]; and a database transaction processor operatively coupled to the receiver of database transaction information and to the storage [backend database, 88 of fig. 2].

As to claims 25-27, all limitations of these claims have been addressed in the analysis of claims 11-13 above, and these claims are rejected on that basis.

As to claim 28, Sandhu teaches the invention substantially as claimed. Sandhu further teaches a decoder that extracts the transaction from the electronic message [fig. 17; col. 50, lines 57 to col. 51, lines 8].

As to claims 29-34, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

4. Further references of interest are cited on Form PTO-892 which is an attachment to this office action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo, whose telephone number is (703) 305-1091. The examiner can normally be reached Monday through Thursday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at (703) 305-3830.

The fax phone number for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238 (After Final Communication)

(703) 746-7239 (Official Communication)

(703) 746-7240 (For Status inquiries, draft communication)

and/or:

(703) 746-5616 (*Use this Fax#, only after approval by Examiner, for "INFORMAL" or "Draft" communication. Examiner may request that a formal/amendment be faxed directly to them on occasions*).

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**6. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 308-5359, (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington.

VA., Sixth Floor (Receptionist).

A handwritten signature in black ink, appearing to be 'Thuy Pardo', with a long horizontal line extending to the right.

Thuy Pardo  
March 27, 2003